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APPLICATION NO. 08/870,591	FILING DATE 06/06/97	FIRST NAMED INVENTOR ESCH	ATTORNEY DOCKET NO. H 08594327
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EXAMINER HENDRICKSON, S

ART UNIT 1754	PAPER NUMBER 33
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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 33

Application Number: 08/870,591
Filing Date: 6/6/97
Appellant(s): Heinz Esch et al.

Ann Hobbs
For Appellant

EXAMINER'S ANSWER

DEC 03 1999

GROUP 00

This is in response to appellant's brief on appeal filed 7/28/99.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

Appellant's statement of issues is correct; it is noted that the rejection under '112 second paragraph is hereby withdrawn in view of appellant's arguments and upon reconsideration of the rejection.

(7) Grouping of Claims

All claims stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,681,750	JOHNSON et al.	7-1987
4,704,425	LAGARDE et al.	11-1987

(10) New Prior Art

No new prior art has been applied in this examiner's answer.

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 7 are rejected under 35 U.S.C. § 103 as obvious over Lagarde et al.

The reference teaches in col.2 lines 5-35 and col.9 lines 1-10 silica having BET 242, CTAB 237, BET/CTAB=1.02. The pore and silanol density properties claimed but not discussed by

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Lagarde are deemed possessed by the product of Lagarde since the BET, CTAB and the ratio thereof are indicative of the structure of the material and are the same as claimed.

Lagarde differs in the "aggregate" (ie particle)size. However the general values disclosed in col. 2 lines 1-35, of a particle size of essentially less than 45 microns subsumes the claimed size range.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results, see *In re Aller et al.*, 105 U.S.P.Q. 233.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson et al. (4681750).

Johnson teaches in col. 2 line 25-col. 3 line 5 and col. 5 lines 35-68 precipitated silica having BET in the claimed range, made in a manner substantially the same as disclosed. An alkali silicate is acidified at the disclosed temperature to the same pH, continuing the reaction for a desired time period and acidifying again to the same disclosed lower pH. The product is then washed and dried, as disclosed. Even though the claimed physical properties are not disclosed by Johnson, the product thereof is deemed to possess them nonetheless since it was made in essentially the same manner as instantly disclosed.

Note that where the examiner has evidence that the product of the reference is the same as claimed but cannot determine whether all the properties are possessed, the burden is upon the applicant to show a difference; *In re Fitzgerald et al.* 205 USPQ 594.

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(12) *New Ground of Rejection*

This examiner's answer does not contain any new ground of rejection.

(13) *Response to argument*

Concerning Lagarde, the arguments about alleged differences are speculative in that a side-by-side comparison between the respective products has not been made. The arguments imply that a product may not be made in two different ways, however this implication is unproven in this art and untrue in general. Similarly, silica has many uses and the fact that Lagarde uses the silica for something other than rubber does not mean that it is different from the claimed silica material. Finally, as the material of Lagarde is for rubber shoes, some of the desired advantages of wear resistance needed for tires is also needed for shoes. Thus, the uses Lagarde finds do not support the assertion that the silica is different from that claimed. Further, the claims do not require rubber nor recite the alleged unexpected results. The Declaration versus Lagarde does not show that the difference is in a *claimed* feature; while the pH is different, the silanol group density feature appears to encompass such a large range that the low pH material of Lagarde is encompassed therein.

Concerning Johnson, the disclosure thereof is not limited to claim 1 thereof. The claims are not to a process and the argument that the pH is kept at 7.5-10.5 is not persuasive in view of specification pg. 12 line 9. The patentable difference between a two step process versus a "one" step process in which the same two things are done is not seen- especially considering that a process is not claimed. While the Declaration shows a different DBP value for example 1 of Johnson, the other properties are very similar- which lends evidence to the presumption upon which the rejection is based. As the product of ex. 2 of Johnson has lower area and oil

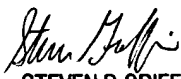
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adsorption, it would appear to fall within the claimed DBP range claimed, since DBP is an oily material. Thus, the Declaration does not compare the closest example of the Johnson disclosure. Note that arguments with respect to compounding in rubber are not persuasive, as this is not claimed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

S. Hendrickson
11/18/99


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